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From: parknfly@visi.com
Sent: Wednesday, April 25, 2001 5:35 PM
To: scpcomments@uspto.gov
Cc: parknfly@visi.com
Subject: 17 areas of your public inquiry regarding harmonization.

Thank you for enabling comment by this medium. I have commented on the 17 listed issues where public comment was requested and where I have an opinion that may be of interest. As a practitioner, I appreciate your attention to my opinions.

My general opinion is informed from the following perspective. First, we must recognize that the U.S. Patent system is the greatest in the world and that any harmonization efforts to improve its efficiency must be made with respect to its value. On the other hand, for the rest of the world that has not been able to generate the same advantages that inure to individual inventors that the U.S. system provides, there is an economic incentive to reduce the value of the U.S. system.

Seen in this light, the first two areas (inventorship claims by first inventor and constitutionally guaranteed "useful arts" tests) should be retained as is.

Enablement, written description, and best mode requirements (item 3) by remaining present in our law, may yield something of value to industry, and strengthen the bargain the U.S. requires of the inventor by fleshing out the requirements of the inventor's consideration given for the patent grant.

I have no strong opinion regarding items 4-8.

Item 9 (the U.S. grace period) is an important protection for the small U.S. inventor and should be retained.

Item 10, eliminating geographic restrictions on definitions of prior art, is a useful means to gain reasonable access to foreign art.

In other words, where non-U.S. art is not available, it should not be valid prior art. Where evidence of invention is unavailable to the U.S. inventor, it should not be available after the patent is granted to invalidate it.

The on sale bar, (Item 11) when applied to not yet reduced to practice inventions should be eliminated, but the rest of the bar makes sense.

Item 12, the use of multiple references to produce an anticipation rejection makes sense in limited circumstances only, but should not be completely eliminated.

There must be a clear suggestion within at least one of the references to combine them in the manner needed to make the rejected claim, and there should be no more than two or possibly three required to be combined and, of course combined, they must contain each element of the claim being rejected.

Regarding using the "problem solving approach", (item 13) I feel this approach produces some good results, but has its own problems. Simply because an invention solves one problem does not mean that it cannot also be used to solve related or different problems. A mechanical application of a problem solving approach is therefore overly restrictive. Where the inventor states the problem narrowly, the true value of the invention may be lost through merely not comprehending the full value of the ideas invented at the time of the invention. If a seminal work were limited in claim scope to the breadth of the problem as stated at the time of the patent application submission, the true value to society of the inventive contribution made by the patentee would be a windfall for the world, thus reducing the strong incentive to get patents which the present U.S. system encourages.

Item 14, multiple dependent claims practice, in the U.S. seems silly. The European approach seems much more economical.

Regarding peripheral claiming approach versus central claiming, (Item 15) I believe that any law changing the court room approach to this will inevitably lead to confusion and must be avoided.

Confusion regarding the scope of claims is anethma to a strong patent system and I believe the law should not be tinkered with regarding this issue.

Regarding Item 16, doctrine of equivalents, I believe here also, the U.S. courts should work this out and we should not confuse the issue with new legislation or treaty rights here.

Regarding Item 17, application in the name of the inventor is a strength of the U.S. system and should not be changed.

Thank you for your attention. If you wish to have further explanation of any of the preceeding remarks, please feel free to contact me.

-Michael Atlass.